

Application No. 10/772,823  
Docket No. 2000U042D1-CON2  
Reply to Office Action Dated 10/06/2004

### Remarks

#### **Amendments**

Claim 1 is amended to include the feature "characterized in that the WPR of the polymer is greater than 10 and less than 30", supported by the specification as filed at, for example, pages 65-66 of the specification as filed. No new matter is added.

#### **Section 102/103 Rejections**

The Examiner maintains the rejection of Claims 1-15 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Brady, III et al. (US 5,317,036) (hereinafter "*Brady*"). The Applicant traverses these rejections and amends the claims accordingly.

The MPEP, supported by case law, clearly states that it is the Examiner's burden to show inherency. The Examiner has not done so here by citing *Brady*.

First, the Examiner states in the Action of October 6, 2004 that the

applicants fail to recognize that the examiner has clearly stated that "in view of substantially identical monomeric compositions and substantially similar catalyst system between the claimed invention and the disclosure in Brady, III et al., the examiner has a reasonable basis to believe that the density . . . being claimed are inherently possessed by the disclosure to Brady, III et al.

The Applicant contends that it simply is not true; the Examiner has not shown that the catalyst system disclosed in *Brady* is "substantially similar" to that disclosed as a primary embodiment by the Applicant. While the Applicant's claims are not so limited, the Applicant has clearly shown in the specification as filed an embodiment wherein the catalyst system is quite distinct from that in *Brady*. *Brady* discloses the use of a single metallocene, while Applicant discloses, for example, the use of two or more catalysts, such as in Example 6, page 74, of the specification as filed.

Second, in response to the Applicant's last Remarks of September 21, 2004 that the *Brady* reference does not disclose bimodal resins, the Examiner states that

Application No. 10/772,823  
Docket No. 2000U042D1-CON2  
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applicants must recognize that these argued features are not [an] indication that the polymers produced in the process of Brady, III et al. are unimodal.

Again, the Applicant contends that there is no indication in *Brady* of bimodal resins. There are any number of references that can be found in the art that disclose the polymerization of olefins and "monomeric compositions", as *Brady* does disclose. However, it is the Examiner's burden to show that *Brady* discloses bimodal resins, or a technical rational as to why such resins are inherent therein.

Again, the law on inherency is clearly elucidated in *In re Best* and *In re Rijckaert*. In *In re Best*,<sup>1</sup> the court found that the prior art ("Hansford") had particularly disclosed each claim element of the subject patent application except for the rate of cooling of the composition after having been heated and the removal of an otherwise volatile species generated from the claimed process. As mentioned in the last Response, the Examiner in *Best* demonstrated, using an objective technical rational,<sup>2</sup> how each and every claim element in the *Best* application was disclosed by, and necessarily flows from, the Hansford disclosure.

The MPEP, citing *In re Rijckaert*,<sup>3</sup> states that the "fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."<sup>4</sup> In *In re Rijckaert*, the court found that the Examiner erred in assuming that there was an inherent relationship between the claimed features in the prior art without finding any rational for that relationship.<sup>5</sup> It is the Examiner's burden to provide a basis, with extrinsic evidence,<sup>6</sup> that the alleged inherent

<sup>1</sup> *In re Best* at 1253-54. Specifically, the court outlined the Examiner's rational: "In rejecting claims 1-7 on Hansford, the examiner asserted that a major portion of any ammonia generated during calcination would inherently be removed from contact with the zeolite, because the gaseous atmosphere disclosed by Hansford was in the form of a moving stream. Also with respect to Hansford, the examiner believed the cooling rate of the zeolite after stabilization to be within the terms of the appealed process claims. The claimed product being the unique result of the claimed process, the examiner, therefore, rejected both process and product claims as anticipated by Hansford, or, in any case, as obvious in view of Hansford."

<sup>2</sup> *In re Best* at 1253-54.

<sup>3</sup> 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993).

<sup>4</sup> MPEP § 2112, at 2100-54. (emphasis in original) (citing *In re Rijckaert*, 9 F.3d 1521, 1534 (Fed. Cir. 1993)).

<sup>5</sup> *In re Rijckaert* at 1533.

<sup>6</sup> "objective evidence or cogent technical reasoning" MPEP at 2100-55 (citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990))

Application No. 10/772,823  
Docket No. 2000U042D1-CON2  
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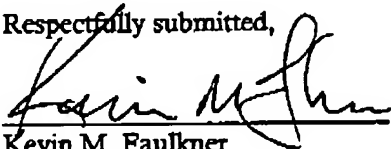
characteristic necessarily flows from the teachings of the prior art.<sup>7</sup> The Applicant contends that the Examiner has not met that burden here set by the MPEP.

Bimodal resins have been disclosed in general in the prior art, but have not solved the problems addressed by the current invention. For example, the Applicant requests that the Examiner consider, for example, WO 95/11264 (US 5,539,076) cited in the previous IDS. Nonetheless, Applicant's claims are inventive, as it is known in the art that the particle morphology of polymer produced can vary depending on catalyst activity,<sup>8</sup> the activity in turn dependent upon the catalyst itself and how it is used in the process (supported, dry, slurry, liquid added, etc.). Further, the GPC plots of the resins disclosed in WO 95/11264 do not disclose the claimed "WPR". Thus, the claimed features are not predictable from the prior art.

It is submitted that the case is in condition for allowance. The Applicant invites the Examiner to telephone the undersigned attorney if there are any other issues outstanding which have not been presented to the Examiner's satisfaction.

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Date

Respectfully submitted,

  
Kevin M. Faulkner  
Attorney for Applicants  
Registration No. 45,427

Univation Technologies, LLC  
5555 San Felipe, Suite 1950  
Houston, Texas 77056-2723  
Phone: 713-892-3729  
Fax: 713-892-3687

<sup>7</sup> *Id.* (citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

<sup>8</sup> *See, e.g.*, 2 Metallocene-based Polyolefins 322-325 (Wiley & Sons, 2000) (cited in the accompanying IDS).